

REMARKS

The Final Rejection of May 2, 2007 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Final Rejection. Applicants appreciate the Interview with the Examiner on June 6, 2007, and the follow-up conversation on June 8, 2007, both summarized in the Interview Summary of June 15, 2007.

I. STATUS OF THE CLAIMS

Claims 1, 3-30 are pending in the application.

Dependent claim 30 has been amended to clarify its terminology. No new matter has been added.

Claim 30 is rejected under 35 U.S.C. § 112, first paragraph.

Claims 6, 8-9, 11, 13-15, 18, and 28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ryan, Jr. et al., United States Patent # 7,071,437, issued on July 4, 2006, published on July 3, 2003, filed on December 31, 2001 (Ryan). Applicants respectfully point out that Ryan was published within a year of Applicants' filing date, October 30, 2003. Applicants reserve the right to swear behind Ryan.

Claims 1, 3, 5, 7, 10, 12, 22-26, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone, United States Patent Application # 2002/0141,613, published on October 3, 2002, filed on March 27, 2001 (Sansone).

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan as modified by Sansone, and in further view of Lopez, United States Patent Application # 2002/029,202, published on March 7, 2002, filed on December 13, 2000 (Lopez).

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield, United States Patent # 6,025,931, issued February 15, 2000 (Bloomfield).

Claims 19-21 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

II. SUBSTANCE OF THE INTERVIEW OF JUNE 6, 2007

In the Interview of June 6, 2007, Applicants sought to explain to the Examiner the difference between Applicants' profile and the prior art image characteristics databases, and to discuss other rejections. Applicants disagree with the Interview Summary of June 15, 2007, in three ways:

- (1) The Interview Summary states that "the profile taught by the cited references taught a profile having only one different characteristic". Applicants respectfully point out that none of the prior art teaches a profile as Applicants have defined the term in Applicants' Specification.
- (2) The Interview Summary states that Applicants "wanted to define the profile as having multiple characteristics". Applicants respectfully point out that Applicants have claimed "at least one profile image characteristic" that is part of a profile, i.e. Applicants have already claimed a profile with multiple characteristics (Applicants' claim 1, for example). Further, Applicants' exemplary profile includes multiple characteristics (Applicants' Specification, paragraph 24).
- (3) The Interview Summary states that Applicants "agreed that the new matter issue did exist toward the updated predetermined profile". Applicants do not agree that new matter existed in amended claim 30, but have further amended claim 30 to delete the clause at issue.

III. REJECTIONS UNDER 35 U.S.C. § 112

On pages 6-7, in paragraphs 6-7, the Office Action states that claim 30 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Although Applicants submit that the limitation “or one updated predetermined profile” is fully supported in Applicants’ Specification, Applicants have amended claim 30 to exclude the limitation. However, Applicants herein argue that the step (m) repeating steps (i) through (l) for another one of the plurality of new or updated predetermined profiles is fully supported in Applicants’ Specification. It is submitted that Applicants’ Specification, paragraph 8, along with paragraphs 32-35, support step (m) in claim 30. Applicants’ Specification, paragraph 8 states steps (g) – (l) for identifying mail pieces, and states that the steps can also be applied to archival mail processing, which is the subject of Applicants’ claim 30.

In a specific embodiment of the method of this invention, image characteristics for an image of a mail piece being examined are obtained from a Remote Computer Reader (RCR). A threat profile is then retrieved from a profiling configuration file (database). The threat profile is then compared to the image characteristics in order to determine whether the image characteristics match the threat profile. If the threat profile matches the image characteristics, the mail piece is identified for special processing. Another threat profile is then retrieved and compared to the image characteristics. If none of the threat profiles match the image characteristics, normal mail processing continues. The method described above can be executed in "Real Time" or can be executed offline (also referred to as "Archival Processing").

Archival mail processing is discussed in Applicants’ Specification, paragraphs 32-35. During a conversation with the Examiner on June 8, 2007, the Examiner stated that step (m) of Applicants’ claim 30 is supported by Applicants’ Specification.

IV. REJECTIONS UNDER 35 U.S.C. § 102

On pages 6-12, in paragraphs 7-8, the Office Action states that claims 6, 8-9, 11, 13-15, 18, and 28 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Ryan.

Applicant respectfully points out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims.

It is submitted that, with respect to independent claims 6 and 11, Ryan does not anticipate Applicants' claimed database storing data for each one of a plurality of predetermined profiles, where the data are an identifier, at least one profile image characteristic, and an action identifier because Ryan's suspect database simply stores criteria (Ryan, col. 10, lines 64-68). Ryan does not state or suggest that the criteria are members of profiles, nor that the criteria are data such as an identifier or an action identifier. Instead, Ryan simply states that "The suspect database contains various criteria such as the criteria described above (under the heading SUSPECT/HARMFUL MAILPIECES) for determining a suspect mailpiece." (Ryan, col. 12, lines 15-18). Further, it is not obvious from Ryan's disclosure that either an identifier or an action identifier would be stored in Ryan's suspect database because Ryan simply compares an image with the contents of the suspect database and takes a single action and therefore does not need to waste the space in the database for unneeded data. Even a broad interpretation of Ryan's suspect database neither anticipates nor makes obvious Applicants' claimed database storing an identifier and an action identifier, along with at least one profile image characteristic, because Applicants' claimed identifier and action identifier are not expressly or inherently found in Ryan.

It is submitted that dependent claims 8-9, 13-15, 18, and 28 are patentable at least by virtue of their selective direct or indirect dependence upon independent claims 6 and 11.

Since Ryan does not teach each and every element of Applicants' independent claims 6 and 11 and claims 8-9, 13-15, 18, and 28 which depend selectively therefrom, Applicants' independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, are not anticipated by Ryan, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Further, it is submitted that independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28 are not made obvious by Ryan under 35 U.S.C. § 103. Applicants assert that independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, are now in condition for allowance. Applicants respectfully request the withdrawal of the

rejection under 35 U.S.C. § 102(e) with regards to independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, for the reasons set forth above.

V. REJECTIONS UNDER 35 U.S.C. § 103

On pages 10-16, in paragraphs 10-11, the Office Action states that claims 1, 3, 5, 7, 10, 12, 22-26, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

In order for a rejection under 35 U.S.C. § 103 to be sustained, the Office Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

It is submitted that independent claims 1 and 22 are not made obvious by Ryan in view of Sansone because (1) Ryan does not disclose Applicants' claimed repeating steps (c) through (e) for another one of the plurality of predetermined profiles, if the at least one profile image characteristic does not substantially match the at least one mail piece image characteristic, and (2) Sansone cannot make up this deficiency because neither does Sansone disclose Applicants' claimed repeating steps (c) through (e). With respect to (1), Applicants agree with the Office Action that states that Ryan Jr. fails to specifically suggest repeating steps (c) through (e) (Final Rejection, page 11, paragraph 11) because Ryan performs a single comparison, and also because Ryan does not include the concept of profiles as Applicants have claimed and described (Applicants' Specification, paragraph 24). With respect to (2), Sansone does not disclose or suggest Applicants' claimed repeating the step of

retrieving another profile, because Sansone does not include the concept of a profile as Applicants have defined in, for example, Applicants' Specification, paragraph 24. Sansone performs a sequential comparison, first against a threat criteria database, then against a sender database, then against a recipient database, and so on. Sansone's comparisons are defined and limited to the stated databases. Applicants, on the contrary, claim the step of comparing mail piece image characteristics with profile characteristics such as those stated in an exemplary profile in Applicants' Specification, paragraph 24, that includes, for example, initiating P&DC, destination address, destination-address style (e.g. handwritten), return-address style (e.g. not present), POSTNET bar code (e.g. not present), and envelope length (e.g. 7 inches), and then repeating the step of comparing for another profile. Applicants' system is clearly different from, more flexible than, and not obvious from Sansone because Applicants can establish any image characteristic in a profile, whereas Sansone is limited to a specific sequence of comparisons against a specific set of characteristics. Therefore, Ryan and Sansone, either separately or in combination, do not state a *prima facie* case for obviousness because Ryan and Sansone do not teach or suggest all the claim limitations. In particular, neither Ryan nor Sansone nor their combination teaches or suggests Applicants' claimed repeatedly retrieving other profiles if a comparison profile characteristic does not match a mail piece image characteristic.

It is submitted that dependent claims 3 and 5 are not obvious in view of Ryan and Sansone at least because of their dependence on allowable independent claim 1.

It is submitted that dependent claims 7, 12, and 23 are not made obvious by Ryan in view of Sansone because neither Ryan nor Sansone states Applicants' claimed action identified by the action identifier from the retrieved data. As stated previously, Ryan does not state or suggest that the criteria are stored as profiles, nor that the criteria are data such as an identifier or an action identifier. In fact Ryan teaches away from such an interpretation because Ryan lists criteria (Ryan, col. 5, lines 20-65), and the list does not include an identifier or an action identifier. Sansone cannot make up the deficiency in Ryan because not only does Sansone not state Applicants' claimed profiles that include data comprising an identifier, an image characteristic, and an action identifier, but Sansone states completely particular databases for particular characteristics such as threat characteristics, sender names, etc., and none of these databases is stated to contain anything but the particular characteristic. Thus Sansone neither states nor suggests Applicants' claimed database having an identifier or an action identifier where the database also includes an image characteristic. In dependent claims 7, 12,

and 23, Applicants' claim an action identified by the action identifier that is part of the profile database claimed in independent claims 6, 11, and 22. Because neither Ryan nor Sansone states or suggests such a database, their combination cannot make out a *prima facie* case of obviousness.

It is submitted that dependent claims 10, 24-26, and 29 are not obvious in view of Ryan and Sansone at least because of their dependence on allowable independent claims 1, 6, and 22.

It is submitted that step (m) of dependent claim 30 is not made obvious by Ryan and Sansone for the same reasons stated with respect to independent claims 1 and 22. Therefore, Ryan and Sansone, either separately or in combination, do not state a *prima facie* case for obviousness because Ryan and Sansone do not teach or suggest all the claim limitations of dependent claim 30. In particular, neither Ryan nor Sansone nor their combination teach or suggest Applicants' claimed repeatedly retrieving other profiles if a comparison profile characteristic does not match a mail piece image characteristic.

On page 16, in paragraph 12, the Office Action states that dependent claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Lopez.

It is submitted that dependent claim 4 is not obvious in view of Ryan, Sansone, and Lopez for the same reasons stated with respect to independent claims 1 and 22, and dependent claim 30, namely because neither Ryan nor Lopez nor their combination discloses or suggests Applicants' claimed step of repeating steps (c) through (e) for another one of the plurality of predetermined profiles, if the at least one profile image characteristic does not substantially match the at least one mail piece image characteristic. As stated previously with respect to independent claims 1 and 22, Ryan and Sansone lack this step. Lopez does not make up the deficiency because Lopez performs certain steps on-line, and a different set of steps off-line, none of which steps include comparing a particular mail piece against multiple profiles.

On pages 17-18, in paragraph 13, the Office Action states that dependent claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield.

It is submitted that dependent claims 16 and 17 are not obvious in view of Ryan and Bloomfield because neither Ryan nor Bloomfield nor their combination discloses or suggests Applicants' claimed remote server having computer readable code that identifies the mail piece as

requiring the action identified by the action identifier from the retrieved data. Ryan does not disclose Applicants' claimed remote server having computer readable code that includes an action identified by the action identifier from the retrieved data for the reasons stated previously with respect to dependent claims 7, 12, and 23. Bloomfield does not make up for Ryan's deficiency because Bloomfield simply forwards e-mail (Bloomfield, col. 7, lines 49-59) without reference to any sort of action identifier in a profile database.

On pages 18-19, in paragraph 14, the Office Action states that dependent claims 19-21 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

It is submitted that dependent claims 19-21 and 27 are not obvious in view of Ryan and Sansone at least because of their dependence on allowable independent claims 1, 6, 11, and 22.

Since none of Ryan, Sansone, Lopez, or Bloomfield, either individually or in combination, teach or suggest each and every element of Applicants' claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, Applicants' claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, are not made obvious by Ryan, Sansone, Lopez, and Bloomfield, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, for the reasons set forth above.

VI. CONCLUSION

Independent claims 1, 6, 11, and 22 are believed to be in condition for allowance for the reasons provided herein. It is submitted that dependent claims 3-5, 7-10, 12-21, and 23-30 are also allowable for the reasons presented above, and further because they depend upon independent claims which are believed to be in condition for allowance, and are therefore also believed to be in condition for allowance.

Although no additional fees are anticipated, the Commissioner for Patents is authorized to charge additional fees, or credit overpayment, to Deposit Account No. 03-2410, Order No. 12078-194.

Appl. No. 10/697,533
Amdt. Dated June 29, 2007
Reply to Final Rejection of May 2, 2007
Docket No.: 12078-194

The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,
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Date: June 29, 2007

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